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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,691	05/15/2001	Tadashi Endo	029650-097	8113

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

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DATE MAILED: 10/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,691

Applicant(s)

ENDO ET AL.

Examiner

Barbara Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 1 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed May 7, 2003 has been received.
2. Claims 1, 17-19 are present. Claims 2-15 were cancelled and new claim 19 was added.
3. The objection to claims 7 and 8 and the 35 USC 102(b) rejection over Nishino et al. are withdrawn in light of the cancellation of claims 2-16.
4. The 35 USC 103(a) rejection over Urano et al. in view of Nishino et al. (US 6,264,821) is withdrawn in light of the amendment.

Priority

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being obvious over Sawada et al. in view of Urano et al.

- a. In US Patent No. 5,779,824, Sawada et al. teach an aluminum alloy support for a planographic printing plate and a method for producing the aluminum

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alloy support (abstract). The aluminum plate is first etched with an alkali at a rate of 0.1 to 5 g/m² and preferably a rate of 0.01 to 1.5 g/m² if the plate contains a large amount of impurities (column 9, lines 15-29). The electrolytically grained aluminum plate is then subjected to dipping in an alkali solution as part of desmutting treatment. As in the alkali pretreatment, caustic soda or the like can be used as the alkali agent (column 9, lines 54-66). Sawada et al. do not specifically teach the etch rate for the desmutting treatment however, it would be obvious to one of ordinary skill in the art to use at least similar conditions for the alkali etching in the desmutting treatment as in the alkali etching pretreatment because both treatments comprise alkali etching. The desmutting treatment comprising the alkali etch treatment meet the present limitations for the alkali etching treatment. An anodized film is formed as a result of the anodic oxidation treatment (column 10, lines 9-20). The anodized film meets the present limitation for the intermediate layer. A photosensitive composition was coated on the obtained supports at a dry coating weight of 2.0 g/m² and subjected to exposure with a metal halide lamp (column 44-67). Sawada et al is silent with respect to the thickness of the photosensitive layer. It would have been obvious to coat the photosensitive layer at a thickness conventional in the art such as the thickness of the photosensitive layer of Urano et al in US Patent No. 6,200,727.

b. In US Patent No. 6,200,727, Urano et al teach a positive photosensitive composition that is preferably coated on surface treated aluminum substrate at a thickness of 0.3 to 7 μm to form a positive photosensitive lithographic printing plate (abstract & column 42, lines 15-37).

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c. Therefore it would have been obvious to one of ordinary skill in the art to make a planographic printing plate comprising an etched, grained, desmuted and anodized aluminum alloy substrate, an anodized film and a photosensitive layer wherein the photosensitive layer is coated to a thickness of 0.3 to 7 μm with reasonable expectation of obtaining a low cost planographic printing plate based on the teachings of Sawada et al (column 3, lines 21-27) in view of Urano et al. The Examiner asserts the thinnest 10% of the photosensitive layer of Urano et al having an overall thickness of 0.3 μm falls within the required range of the instant application.

d. It is noted this is a product-by-process claim wherein the plate is defined by the surface treatments. Applicant is reminded of MPEP 2112.02: "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." However, with respect to present claim 1, Sawada et al clearly teach the alkali treatment, the graining treatment and the anodizing treatment as required in the process limitations of the product claim.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Urano et al in view of Nishino et al.

a. In US Patent No. 6,200,727, Urano et al. teach a positive photosensitive composition comprising an alkali soluble resin having phenolic hydroxyl groups, of

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which at least some esterfied (a) and a photo-thermal conversion material (b), and not containing a quinonediazide compound (abstract). The alkali soluble resin and photothermal conversion material of Urano et al meet the present limitations for the high-molecular compound and the infrared absorbent respectively. The photosensitive composition is preferably coated on surface treated aluminum substrate with a roughness of 0.3 to 1.0 μm to form a positive photosensitive lithographic printing plate precursor (column 42, lines 15-44) which can be exposed with a laser beam having a wavelength within a range of from 650 to 1,300 nm and then developed to form a positive image (column 3, lines 19-24). Urano et al. do not teach the 85 deg. glossiness of the aluminum substrate.

b. In EP 960 743 A2 Nishino et al. teach an aluminum support for lithographic printing plate and production method thereof wherein an aluminum support is produced by surface graining and then polishing or by polishing while etching in an aqueous acid or alkali solution (abstract). The aluminum substrate comprises an 85 deg. gloss of 1 to 40 (column 21, [0116]) which meets the present limitations for claimed 85 deg. glossiness range. Nishino et al. do not disclose the dimensions of the concave portions. However, the Examiner asserts one of ordinary skill in the art would expect properties inherent to the substrate to be similar to the properties of the substrate of the present application such as those of the concave portions because of the identical glossiness of the two substrates.

c. Therefore it would have been obvious to one of ordinary skill in the art to coat a surface treated aluminum substrate having a roughness of 0.3 to 1.0 μm with an

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alkali soluble resin comprising phenolic hydroxyl groups, of which at least some esterified, a photo-thermal conversion material and not containing a quinonediazide compound wherein the support has an 85 deg. glossiness of 30 or less with reasonable expectation of obtaining a low-cost aluminum substrate based on the teachings of Nishino et al (abstract).

Response to Arguments

9. Applicant's arguments filed May 7, 2003 have been fully considered but they are not persuasive.

a. Applicant argued that the alkali etching treatment of present claim 1 is required to be subsequent to the graining treatment and pointed to the alkali pretreatment of Sawada et al. Applicant also stated the desmutting treatment of Sawada et al. does not meet the present claim limitations however as pointed out above one of ordinary skill in the art would use the at least similar conditions for the alkali etching in the desmutting treatment as in the alkali etching pretreatment. Additionally this is a product-by-process claim. Applicant is reminded of MPEP 2112.02.

10. Applicant argued that the rejection over Nishino et al. '821 is legally incorrect. At the time of the first action on the merits, the rejection over Nishino et al. under 35 U.S.C. 103(a) was perfectly legal. According to the MPEP, Nishino et al. constitutes prior art only under 35 U.S.C. 102(e) based upon the earlier effective U.S. filing date of the reference. This rejection was overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See

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MPEP § 706.02(l)(1) and § 706.02(l)(2). In light of Applicant's statement with respect to assignment, this rejection is withdrawn.

c. Applicant argued that if Japanese published applications of Nishino et al. were constituted prior art, the applications still would not result in the current embodiment and would not provide an appreciation of the advantages of the present application. No Japanese published applications were used to reject the claims of record. EP 960 743 A2 (which has a publication date of December 1, 1999), was used to reject the claims. Applicant is reminded that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Additionally Applicant has not pointed to any specific data that would support the "advantages." See MPEP 716.02.

Allowable Subject Matter

11. Claims 17 and 18 are allowed.

12. The following is an examiner's statement of reasons for allowance:

a. There is no teaching or suggestion in the prior art of record, specifically JP 62-109041 of a support comprising an anodized layer thereon wherein the anodized layer comprises micropores with a diameter and density to satisfy the inequality equation required in claim 17. In JP 62-109041, the average pore can be 900 Angstroms and the density is 100 pieces/m² (abstract), which does not satisfy the inequality equation of claim 17.

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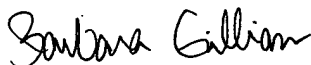
b. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 703-305-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

b. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Barbara Gilliam
Examiner, AU 1752
October 13, 2003